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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO.       |
|--|-------------|----------------------|------------------------------|------------------------|
| 10/022,592   | 12/13/2001  | Victor B. Lortz      | 884.501US1                   | 6044                   |
| 7590 09/18/2007<br>Schwegman, Lundberg, Woessner & Kluth, P.A.<br>P.O. Box 2938<br>Minneapolis, MN 55402 |             |                      | EXAMINER<br>DAVIS, ZACHARY A |                        |
|  |             |                      | ART UNIT<br>2137             | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>09/18/2007      | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/022,592 | <b>Applicant(s)</b><br>LORTZ, VICTOR B. |  |
|                              | <b>Examiner</b><br>Zachary A. Davis  | <b>Art Unit</b><br>2137                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05 July 2007 has been entered.
2. By the above submission, Claims 1 and 8-14 have been amended. No claims have been added or canceled. Claims 1-14 are currently pending in the present application.

### ***Response to Arguments***

3. Applicant's arguments filed 05 July 2007 have been fully considered but they are not persuasive.

Claims 1-9 and 12-14 were rejected under 35 U.S.C. 102(e) as anticipated by McGarvey, US Patent 6643774. Claim 10 was rejected under 35 U.S.C. 103(a) as unpatentable over McGarvey in view of Eastlake et al, "XML-Signature Syntax and

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Processing". Claim 11 was rejected under 35 U.S.C. 103(a) as unpatentable over McGarvey in view of Ellison et al, "SPKI Certificate Theory".

In reference to independent Claims 1 and 9, Applicant argues that McGarvey does not disclose the limitation in the claims as amended that the client provides the at least one first certificate directly to the authorizer, and that McGarvey "describes a system where the third party receives the certificate and then forward [sic] it on" (see pages 7-8 of the present response). However, as noted in the previous Office action, the Examiner believes that, in the description of McGarvey, forwarding the certificate is used as a synonym for "tunneling" (see McGarvey, column 11, lines 54-55), where tunneling is suggestive that the actual transmission or provision of the certificate is at base between the client and the private key system, the latter corresponding to the claimed authorizer (column 11, lines 61-66, for example). Applicant has explicitly stated that the amendment to the claim "is not intended to say that there are no network routers, hubs, switches, or other devices that enable computing devices to communicate over a network" (page 6 of the present response), and the Examiner believes that a server acting to perform a tunneling operation would be encompassed by at least the last category, i.e. it would be a device enabling computing devices to communicate over a network. Therefore, the Examiner believes that McGarvey does disclose the providing limitation as claimed.

Further, Applicant's arguments that "McGarvey fails to provide as comprehensive of a security system as the present claims" (page 8 of the present response) fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the

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claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Although Applicant alleges that the third party in McGarvey may take particular actions, this is mere conjecture that is not substantiated by any evidence from McGarvey or elsewhere. Further, in response to the related argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "each time the third party takes action, the third party's authority to take the action on part of the client needs to be verified", page 8 of the present response) are not explicitly recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Additionally, assuming *arguendo* that the statement that the system of McGarvey is not as comprehensive a security system as that of the claimed methods were true, this would not necessarily preclude the methods as disclosed by McGarvey from anticipating the presently claimed invention.

Therefore, for the reasons detailed above, the Examiner maintains the rejections as set forth below.

### ***Specification***

4. The objection to the specification for failure to provide antecedent basis for the claimed subject matter is withdrawn in light of the amendments to the claims.

***Claim Rejections - 35 USC § 101***

5. The rejection of Claims 9-14 under 35 U.S.C. 101 as directed to non-statutory subject matter is withdrawn in light of the amendments to the claims.

***Claim Rejections - 35 USC § 112***

6. The rejection of Claims 1-14 under 35 U.S.C. 112, first paragraph, for failure to comply with the written description requirement is withdrawn in light of the amendments to the claims. The rejection of Claims 1-7 and 9-14 under 35 U.S.C. 112, second paragraph, as indefinite is withdrawn in light of the amendments to the claims. The rejection of Claim 8 under 35 U.S.C. 112, second paragraph, is maintained; although the previous issues of indefiniteness are moot in light of the amendments to the claims, the amendments also raise new issues of indefiniteness.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites the limitation "not providing the first certificate, by the client to the authorizer, the at least one first certificate". First, this is generally unclear. More

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particularly, in reference to the last phrase, "the at least one first certificate", it is not clear what this is intended to be the object of or otherwise modify. Further, the limitation "the first certificate" has insufficient antecedent basis, as there is prior recitation of "at least one first certificate", and if there is more than one certificate, it is not clear to which certificate this is intended to refer. Further, this limitation appears to explicitly contradict the limitation in Claim 1 of providing the at least one first certificate by the client to the authorizer. All of this renders the claim indefinite.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-9 and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by McGarvey, US Patent 6643774.

In reference to Claim 1, McGarvey discloses a method including a client storing a first certificate from an authorizer, the client storing a URI associated with the first certificate and a third party, the client providing a certificate and the URI to the third party (see column 12, lines 22-26), and the client providing the first certificate directly to

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the authorizer in response to the authorizer accessing the URI, in which the client retains control over the third party's use of the first certificate (see Figures 3 and 8, where the client 300 corresponds to the client of the present claim, the server 310 corresponds to the third party of the present claim, and private key system 330 corresponds to the authorizer of the present claim; see also column 11, line 37-column 12, line 11, where, *inter alia*, the certificate is tunneled directly from the client to the private key system, i.e. authorizer).

In reference to Claims 2 and 3, McGarvey further discloses providing a short-term use certificate to the third party (column 12, lines 30-35; column 8, lines 8-13).

In reference to Claim 4, McGarvey further discloses authenticating the authorizer upon accessing the URI (column 11, lines 60-61).

In reference to Claims 5 and 6, McGarvey further discloses limiting and tracking the third party's use of the first certificate (column 8, lines 8-13).

In reference to Claim 7, McGarvey further discloses that the contents of the first certificate are not revealed to the third party (see column 11, lines 42-46).

In reference to Claim 8, McGarvey further discloses determining that the third party's ability to use the first certificate is not authorized (see column 12, lines 30-36).

In reference to Claim 9, McGarvey discloses a method including a client receiving a first certificate from an authorize, the client generating a URI associated with the first certificate and a third party, the client providing a second certificate and the URI to the third party (see column 12, lines 22-26), and the client providing the first



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certificate directly to the authorizer upon the authorizer accessing the URI after the third party has provided the second certificate and URI to the authorizer (see Figures 3 and 8, where the client 300 corresponds to the client of the present claim, the server 310 corresponds to the third party of the present claim, and private key system 330 corresponds to the authorizer of the present claim; see also column 11, line 37-column 12, line 11, where, *inter alia*, the certificate is tunneled directly from the client to the private key system, i.e. authorizer).

In reference to Claim 12, McGarvey further discloses that the third party is granted access to a resource of the authorizer (column 8, lines 4-19).

In reference to Claim 13, McGarvey further discloses tracking a use of the second certificate (column 8, lines 8-13).

In reference to Claim 14, McGarvey further discloses that the second certificate can be revoked (column 8, lines 10-13; column 12, lines 30-36).

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGarvey in view of Eastlake et al, "XML-Signature Syntax and Processing".

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McGarvey discloses everything as applied above to Claim 9. However, McGarvey does not explicitly disclose the use of XML signatures. Eastlake discloses that XML signatures can be used to apply digital signatures to the content of resources that may be external to the signature itself (page 4, section 1.0, "Introduction"). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of McGarvey to include the use of XML signatures, in order to provide integrity and message or signer authentication (see Eastlake, page 1, Abstract).

13. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGarvey in view of Ellison et al, "SPKI Certificate Theory".

McGarvey discloses everything as applied above to Claim 9. However, McGarvey does not explicitly disclose the use of SPKI certificates. Ellison et al disclose that authorization certificates can be used to delegate authorizations (page 14, section 4, "Delegation") and that SPKI certificates can be used to define an authorization certificate (page 13, section 3.3, "SPKI Certificates"). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of McGarvey to include the use of SPKI certificates, in order to allow for authorizations to be delegated without needing to involve the owner of the resource concerned (see Ellison, page 14, section 4).

***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Wray, US Patent 7237107, discloses a system for assembling trust chains using certificates for delegation, particularly SPKI certificates.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A. Davis whose telephone number is (571) 272-3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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